


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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I hereby certify that this correspondence is being faxed to Karin Tyson, Supervisor of the Legal Department of the U.S. Patent and Trademark Office, Washington, D.C. 20231 on February 14, 2002.


Marilyn R. Khorsandi

In re application of : Daniel F. Williams, et al.
Title : Apparatus, Systems and Methods for Online, Multi-Parcel, Multi-Carrier, Multi-Service Parcel Returns Shipping Management

Application No. : 09/820292
Filed : March 27, 2001

Examiner :
Group No. : 2161

Attorney Docket No.: PSTM0042/MRK

**ATTN: Karin Tyson
Legal Department
Electronic Application Review
Office of Initial Patent Examination
Assistant Commissioner for Patents
Washington, D.C. 20231**

February 14, 2002

**REQUEST FOR RECONSIDERATION UNDER 37 CFR §1.111
OR IN THE ALTERNATIVE
REQUEST UNDER 37 CFR §1.183 FOR *SUA SPONTE* SUSPENSION OF THE
RULES AS INTERPRETED**

Dear Assistant Commissioner:

Pursuant to 37 CFR §1.111, this is a request for reconsideration of a decision to reject a Request for Redacted Publication in the above-identified application and of an interpretation of 37 CFR §1.217 and 37 CFR §1.8 by which the adverse decision was reached. In the alternative, this is a request, pursuant to 37 CFR §1.183, for *sua sponte* suspension of the rules as interpreted.

This request for reconsideration, or in the alternative, for suspension of the rules, is in response to a Pre-Grant Publication Rejection Notice dated February 6, 2002 and to telephone conversations with Mark Polutta of the legal department for the Patent and Trademark Office.

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In a telephone call, Mark Polutta advised that in the above-named case, the Request for Redacted Publication was to be rejected. On the date of this request, Applicant received formal written notification of the decision in the form of a Pre-Grant Publication Rejection Notice. Because of certain timing considerations, Mark Polutta previously suggested that this request be forwarded in writing via facsimile as soon as possible.

GROUND'S FOR REJECTION

The Pre-Grant Publication Rejection Notice is based on grounds that the hardcopy submission as required by 37 CFR §1.217(c) was not timely. Even though the hardcopy submission was mailed, and certified as mailed, on the date on which the electronic filing had been made, the Request for Redacted Publication was rejected because it was filed with first class mail, not Express Mail, and was not received in the Patent and Trademark Office (the Office) within the sixteen month deadline for filing the electronic Request for Redacted Publication. In a telephone conversation, Mark Polutta indicated that the underlying reason for the rejection was that, contrary to 37 CFR §1.8, the first class mailing was not considered timely because 37 CFR §1.217(e) states that "[t]he provisions of §1.8 do not apply to the time periods set forth in this section."

STATEMENT OF FACTS AND CIRCUMSTANCES

The facts and circumstances regarding the electronic Request for Redacted Publication in the above-identified application are as follows. The above-identified application was filed on March 27, 2001; it claims priority to U.S. Provisional Patent Application Serial Nos. 60/192,692, 60/195,748, and 60/232,103 filed March 28, 2000, April 6, 2000, and September 12, 2000, respectively. On Monday, July 30, 2001, a Request for Redacted Publication was filed in compliance with the Office's electronic filing system requirements in accordance with 37 CFR § 1.217(b). The electronic filing was timely and there is no dispute regarding the electronic filing. On that same day, hardcopies as indicated by 37 CFR § 1.217(c) were submitted by first class mail with a certificate of mailing in accordance with the provisions of 37 CFR §1.8 (a)(1). The timeliness of the hardcopy submission is disputed.

REQUEST FOR RECONSIDERATION OF AN INTERPRETATION THAT CREATES A CONFLICT IN THE RULES

Pursuant to 37 CFR §1.111, Applicant respectfully requests reconsideration of the decision to reject the Request for Redacted Publication and of the above-described interpretation of the rules.

Applicant respectfully submits that the hardcopy submissions made with respect to the Request for Redacted Publication in the above-identified case were timely according to 37 CFR §1.8; until such time that 37 CFR §1.8 is amended to enumerate, in paragraph (a)(2) of that section, submissions under 37 CFR §1.217(c), 37 CFR §1.217(e) should be interpreted to mean that 37 CFR §1.8 does not apply to the time deadlines for electronic filings under 37 CFR §1.217. An interpretation otherwise of 37 CFR §1.217(e) that 37 CFR §1.8 as it currently exists does not apply to the hardcopy

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submission as required by 37 CFR §1.217(c) would be contrary to the explicit provisions of 37 CFR §1.8 and would create a conflict in the rules.

37 CFR §1.8 provides that, "[e]xcept in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed." The cases currently enumerated in 37 CFR §1.8 (a)(2) do not include hardcopy submissions under 37 CFR §1.217(c).

Further, 37 CFR §1.217(c) does not require that the hardcopies be received by the Office, or "filed" in the Office, within the sixteen month deadline. Rather, 37 CFR §1.217(c) requires only that the hardcopies be "concurrently submit[ted] in paper". In the case of the above-identified Request for Redacted Publication, Applicant respectfully submits that the hardcopy submission was timely concurrently submitted because the hardcopies were submitted on the same day as the timely electronic filing.

REQUEST IN THE ALTERNATIVE FOR SUSPENSION OF A CONFLICTING RULE

In the alternative, Applicant requests, under 37 CFR §1.183, *sua sponte* suspension of the rules as interpreted by the Office in the Pre-Grant Publication Rejection Notice. Suspension of the rules as interpreted in the Rejection Notice is appropriate for two reasons: 1.) because, as described above, until such time that 37 CFR §1.8 is amended to enumerate, in paragraph (a)(2) of that section, submissions under 37 CFR §1.217(c), an interpretation of 37 CFR §1.217(e) such that 37 CFR §1.8 does not apply to the timeliness of a concurrent 37 CFR §1.217(c) hardcopy submission is in direct conflict with the express provisions of 37 CFR §1.8; and 2.) because the submission in this case did not compromise the timing of the review by the Office of the Request for Redacted Publication.

Sua sponte suspension of the rules is appropriate where, as here, an Applicant is faced with a conflict between two rules and complies with one of the two conflicting rules. Justice requires that if an Applicant, as here, has complied with one rule, the conflicting requirements of a conflicting rule should be suspended.

Sua sponte suspension of the rules is further appropriate where, as here, the purpose and objectives of a rule are not compromised by an Applicant's substantial compliance. In this case, the concurrent 37 CFR §1.217(c) hardcopy submission by first class mail was made on July 30, 2001; a review of the hardcopy submission was not made until February, 2002; the hardcopy submission had long since arrived in the Office by the time the hardcopy submission was reviewed.

The circumstances of the application as described above concerning the hardcopy submission did not compromise the objective of the Office that hardcopy documents be timely received. The timely receipt objectives of the Office were provided in a response in § 65 Fed. Reg. 57,023-57,061, September 20, 2000 to a comment (Comment 68). Comment 68 (§ 65 Fed. Reg. 57,023-57,061, September 20, 2000) suggested that the certificate of mailing provisions of § 1.8 should apply to the filing of materials relating to

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submission of a redacted copy of an application for publication (§ 1.217). In response, the Office replied as follows:

Since the redacted copy of an application for publication must be submitted via EFS (and not via the mail), the certificate of mailing practice set forth in § 1.8 is inapplicable to the submission of a redacted copy of an application for publication. In view of the significant burden that filing a redacted copy of an application for publication places on the Office, the Office considers it appropriate to require such an applicant to provide the Office with the document necessary for processing the application by means that ensure that such documents are promptly received in the Office.

§ 65 Fed. Reg. 57,023-57,061, September 20, 2000, Response to Comment 68.

Under the circumstances of this application as described above, the concurrent 37 CFR §1.217(c) hardcopy submission by first class mail, made on July 30, 2001, had long since arrived in the Office by the time the hardcopy submission was reviewed in February 2002. Therefore, the objective of the rule as interpreted by the Office in the above-mentioned Response was not compromised in this case because the Office had received the documents necessary for processing the application well before the Office began the processing of that application. Accordingly, Applicant respectfully requests suspension of the rule under which the hardcopy submission would be considered untimely.

The Commissioner is authorized to charge any fee required for the submission of this request to **Deposit Account No. 501574**. Please show our docket number with any charge to our Deposit Account.

Respectfully submitted,

February 14, 2002
Date

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Date: February 14, 2002

Re: In re appl. of: Daniel F. Williams, et al.

CC:

Title: Apparatus, Systems and Methods
for Online, Multi-Parcel, Multi-Carrier,
Multi-Service Parcel Returns Shipping
Management

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Group No.: 2161

Attorney Docket No.: PSTM0042/MRK

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